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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

PARKHURST & WENDEL, L.L.P.
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Attorney Docket No.: DAIN:563
Date: May 27, 2003

Prior Application:
Examiner: Ling X. Xu

Mail Stop RCE
COMMISSIONER FOR PATENTS
P. O. Box 1450
Alexandria, Virginia 22313-1450

Art Unit: 1775

Sir:

This is a

[] Continued Prosecution Application (CPA) under 37 CFR §1.53(d);
[X] Request for Continued Examination (RCE) under 37 CFR §1.114
(prosecution of the application is closed in the sense of 37 CFR §1.114(b));
[] Divisional Continuation Application (parent not abandoned) under 37
CFR §1.53(b);
[] Divisional Application (parent being abandoned) under 37 CFR
§1.53(d);

of pending prior application Serial No. 09/684,927, filed October 10, 2000

for [Title as filed]: PROTECTIVE LAYER TRANSFER SHEET

[Amended Title]: same

by [Inventors]: Hideki USUKI, Satoshi MORIGUCHI, and Hitoshi SAITO

1. [] A copy of the prior application is attached. This copy comprises a true copy of the prior application as filed (specification, claims, drawings, declaration). No amendments referred to in the declaration (if any) filed to complete the prior application introduced new matter therein.
2. [] Abandon said prior application as of the filing date accorded this application.

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750.00 OP

PLEASE ACCEPT THIS AS
AUTHORIZATION TO DEBIT
OR CREDIT FEES TO
DEP. ACCT. 16-0331
PARKHURST & WENDEL

3. [X] The filing fee is calculated below:

CLAIMS REMAINING IN AN APPLICATION AFTER ENTRY OF ANY PRELIMINARY AMENDMENT OR AMENDMENT UNDER 37 CFR \$1.116 NOTED BELOW			Basic Fee
Total claims	7	-20 = 0 x \$18.00 (* 9.00) =	-
Independent claims	1	- 3 = 0 x \$84.00 (*42.00) =	-
Total Filing Fee.....			= \$750.00

4. [X] A check in the amount of \$750.00 is enclosed (Ck# 16564).
THE COMMISSIONER IS HEREBY AUTHORIZED TO CHARGE ANY OTHER FEES
WHICH MAY BE REQUIRED OR CREDIT ANY OVERPAYMENT TO DEPOSIT ACCOUNT
NO. 160331.
5. [] Cancel in this application claims of the prior application before
calculating the filing fee. At least one independent claim is
retained for filing purposes.
6. [] Amend the specification by inserting before the first line the
sentence:
--This is a [] Continuation [] Division of application Serial No.
09/684,927 filed October 10, 2000.--
7. [] Please enter in the present application the Amendment Under 37 CFR
\$1.116 with any attachments filed on in said prior application
which was not entered therein.
8. [X] Priority of foreign application(s) No. 1999-292919 filed October
14, 1999 in Japan is claimed under 35 U.S.C. §119.
- [X] The certified copy was filed in prior application No. 09/684,927
on December 15, 2000.
- [] A certified copy of the above corresponding foreign application is
filed herewith.
9. [X] The prior application is assigned of record to DAI NIPPON PRINTING
CO., LTD. Recorded at Reel 011370, Frame 0642.

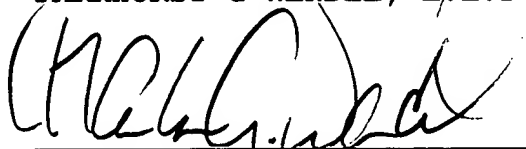
10. [X] The power of attorney in the prior application is to Roger W. Parkhurst, Registration No. 25,177 and Charles A. Wendel, Registration No. 24,453:
- [X] a. The power appears in the original papers in the prior application.
 - [] b. Since the power does not appear in the original papers, a copy of the power in the prior application is enclosed.
 - [X] c. Address all future communications to

PARKHURST & WENDEL, L.L.P.
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11. [X] An Application Data Sheet is enclosed.
12. [X] Further Arguments in Support of Patentability.
13. [] An Information Disclosure Statement is enclosed.
14. [X] This application is not entitled to Small Entity Status.

Respectfully submitted,

PARKHURST & WENDEL, L.L.P.



Charles A. Wendel
Registration No. 24,453

(rev. 01/02)



#15

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Hideki USUKI et al.

Group Art Unit: 1775

Serial No.: 09/684,927

Examiner: Ling X. Xu

Filed: October 10, 2000

For: PROTECTIVE LAYER TRANSFER SHEET

FURTHER ARGUMENTS IN SUPPORT OF PATENTABILITY

Mail Stop Non-Fee
Amendment
Commissioner for Patents
P. O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

The comments at pages 2 to 6 of the Advisory Action mailed April 14, 2003 providing further explanation for the Examiner's position are noted. Applicants respectfully submit, however, that the claims patentably define over the cited art for at least the reasons presented to date and the following reasons.

The advantages of the present invention are achieved by controlling both the quantity of microsilica and the coefficient between the surface of the protective layer and the surface of an image-receiving sheet prior to thermal transfer falling within the

designated ranges for coefficient of static friction and coefficient of dynamic friction. The working and comparative examples so show; the reported values establish patentability. Those values show the differences resulting when operating inside and outside the ranges in the present claims, ranges that differ from the ranges disclosed in the cited references. Thus, the comments on pages 2 to 5 of the Advisory Action about what the individual references disclose don't allow the Examiner to ignore what is shown in the working and comparative examples. To reiterate, the ranges in the claims are not the ranges in the references.

The discussion at pages 5 and 6 of the Advisory Action regarding the comparative and working examples suggests that the Examiner has dismissed any results of the comparative examples merely because the secondary reference suggests using microsilica. The claims are more restricted than merely using microsilica and one must operate within the claimed indicated range (3 to 10% based on a solid resin matter in the adhesive layer) in order to achieve the results of the present invention. It is respectfully submitted that working and comparative examples, if of record in a case, must

be assessed for their evidentiary value in support of patentability. See In re Sernaker, 217 USPQ 1 (Fed. Cir. 1983).

Applicants also inform the Examiner that the value depicted for the amount of silica in working Example 2 at page 17, line 6 is a typographical error; that example contains three parts of silica rather than five parts of silica. The correct value means that the adhesive layer in Example 2 contains about 10% by weight of microsilica based on a resin solid matter in the adhesive layer; that number is the upper limit of the present invention. In contrast, the adhesive layer in Comparative Example 3 contains about 14% by weight of microsilica. The differences are shown for those respective examples both in Table 1 on page 21 and Table 2 on page 23. The advantageous feature obtained by the use of microsilica in a range of 3 to 10% is not taught or suggested by the reference.

An English language version of JIS P 8147 is enclosed for the record.

The Examiner is informed that additional comparative data is being prepared further to establish the patentability of the claimed invention. That additional data will be forwarded to the

Serial No. 09/684,927

Examiner upon completion. If the additional data is not in the file when the Examiner takes the case up for further examination, the Examiner is asked to contact the undersigned.

Favorable treatment of the case is earnestly solicited.

Respectfully submitted,

PARKHURST & WENDEL, I.L.P.



Charles A. Wendel

Registration No. 24,453

May 27, 2003
Date

CAW/ch

Enclosure:

JIS P 8147

Attorney Docket No.: DAIN:563

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